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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Barry L Kelmachter
Bachman & LaPointe PC
Suite 1201
900 Chapel Street
New Haven, CT 06510-2802

EXAMINER

BASHORE, ALAIN L

ART UNIT	PAPER NUMBER
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1762

DATE MAILED: 06/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/662,451

Applicant(s)

LIEBERMANN, RAANAN

Examiner

Alain L. Bashore

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 January 2005.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-64 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-64 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 8, 15, 34-35, 42-64 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 8 there is recited "adverse condition" which is considered vague and indefinite since there is no established meets and bounds. What is considered adverse to one may not be considered adverse to another.

In claim 8 there is recited "potential bodily harm" which is considered vague and indefinite since there is no established meets and bounds. What is considered potential bodily harm to one may not be considered potential bodily harm to another.

In claim 15 there is recited "under duress" which is considered vague and indefinite since there is no established meets and bounds. What is considered duress to one may not be considered duress to another. Also the term may have legal meaning that may vary over time depending on changes in rules and or law.

In claim 35 there is recited "personal safety" which is considered vague and indefinite since there is no established meets and bounds. What is considered personal safety to one may not be considered personal safety to another.

In claim 61 there is recited "the well being of a user" which is considered vague and indefinite since there is no established meets and bounds. What is considered the well being to one may not be considered the well being to another.

For the purposes of this examination claims 42-64 are considered apparatus.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1-16, 23-25, 35-41 are rejected under 35 U.S.C. 101 as non-statutory because the method claims as presented do not claim a technological basis. Without a claimed basis, the claims are interpreted as involving no more than a manipulation outside of a technological art and therefore non-statutory under 35 U.S.C. 101.

In contrast, a method claim that includes in the preamble and body of the claim structural / functional interrelationships that are solely by computer (and non-trivial) are considered to have a technological basis and thus within the technological arts [See Ex

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parte Bowman, 61 USPQ2d 1669, 1671 (Bd. Pat. App. & Inter. 2001) – used only for content and reasoning since not precedential].

Claims which are broad enough to read on statutory subject matter and on nonstatutory subject matter are considered nonstatutory [see In re Lintner, 458 F.2d 1013, 1015, 173 USPQ 560, 562 (CCPA 1972)].

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-7,9, 10-17, 21-22, 35-36, 42-45, and 61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoffman et al in view of Zingher et al.

Hoffman et al discloses a method for carrying out personal transactions. There is registering a user of a system, the user accessing said system and providing said system with personal information about said user (col 4, lines 18-38). The registering step further comprises an identification number for said user and creating a PIN number (col 5, lines 1-16). There is disclosed telephone selection (col 18, lines 14-25) and multiple digits for the PIN number (col 17, lines 35-37). A customer database is utilized (fig 2). Access is disclosed to the system by telephone and computer (col 9, lines 40-

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45). An ATM and money withdrawal utilizing a PIN is disclosed (col 1, lines 45-60), and purchasing merchandise (col 16, lines 1-5).

It would have been obvious to one with ordinary skill in the art to include a specific number of digits (such as ten, or a telephone number as claimed) for the purposes of personal convenience of the user and also because there is taught a range that includes ten digits.

Hoffman et al does not disclose a segment described as a "security segment" of the PIN, or a security segment to signify a condition that is adverse or potential bodily harm or under duress or personal safety, or well being. There is also not disclosed calling the user at an activation time at least one monitoring location.

Zingher et al discloses:

a "security segment" of the PIN where the security segment to signify a condition that is adverse or potential bodily harm or under duress or personal safety, or well being (col 1, lines 23-59); and,

at least one monitoring location (col 9, lines 27-38).

Since Zingher et al discloses reversing, adding to, or modifying a PIN there is disclosed a security segment and change of that segment. It would have been obvious to one with ordinary skill in the art to include a "security segment" of the

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PIN and a security segment to signify a condition that is adverse or potential bodily harm or under duress or personal safety, or well being because of what is taught by Zingher et al. Zingher et al teaches that PIN modification within currently existing system parameters is important that bodily harm can result from victims who are users of PIN numbers (col 1, lines 23-59).

Also Zingher teaches that modifications to the PIN would be within the scope of the invention would therefore be obvious to one with ordinary skill in the art to make other PIN segment modifications as claimed (col 10, lines 33-44).

6. Claims 18-20, 23-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoffman et al in view of Zingher et al as applied to claims above, and further in view of Franklin et al.

Hoffman et al and Zingher et al do not disclose temporary file creation for transaction information transference wherein when a merchandise purchasing step connection allows downloading (as claimed in claims 18-24).

Franklin et al discloses temporary file creation for transaction information transference wherein when a merchandise purchasing step connection allows downloading (col 6, lines 50-56).

It would have been obvious to one with ordinary skill in the art to include temporary file creation for transaction information transference wherein when a merchandise purchasing step connection allows downloading because Franklin et al teaches online merchandise purchases requiring added precautions (col 1, lines 37-50).

7. Claims 25-34, 37-41, 46-60, 62-64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoffman et al in view of Zingher et al as applied to claims above, and further in view of Rodgers et al.

Hoffman et al and Zingher et al do not disclose providing access, identifying the user, storing, notifying of receipt thereof, or voice delivery of: an e- mail communication, a facsimile communication, or a page.

Rodgers et al discloses providing access, identifying the user, storing, notifying of receipt thereof, or voice delivery of: an e- mail communication, a facsimile communication, or a page (col 4, lines 19-34).

It would have been obvious to one with ordinary skill in the art to include providing access, identifying the user, storing, notifying of receipt thereof, or voice delivery of: an e- mail communication, a facsimile communication, or a page because of what is taught by Rodgers et al. Rodgers et al teaches that computerization of

communication systems require versatility in the business environment (col 1, lines 12-39).

Response to Arguments

8. Applicant's arguments filed 1-5-05 have been fully considered but they are not persuasive.

Regarding the rejections of meanings of terms under 35 USC 112, 2nd paragraph, the meets and bounds of the terms are what make these terms indefinite. What these terms may mean to one may mean differently to another, without explicit definition in the specification as to the meets and bounds.

Regarding the 35 U.S.C 101 technical basis requirement, a further explanation of the requirement is given in this office action. Since the term "system" may mean solely apparatus, solely method, or a combination thereof, this term per se is not sufficient to provide technical basis.

The primary reference was modified to provide for PIN segments by one with ordinary skill in the art utilizing the teaching disclosed in the primary reference.

Further Explanation Regarding 35 U.S.C 101 – Technical Basis

9. As an initial matter, the United States Constitution under Art. I, §8, cl. 8 gave Congress the power to "[p]romote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries". In carrying out this power, Congress authorized under 35 U.S.C. §101 a grant of a patent to "[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition or matter, or any new and useful

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improvement thereof." Therefore, a fundamental premise is that a patent is a statutorily created vehicle for Congress to confer an exclusive right to the inventors for "inventions" that promote the progress of "science and the useful arts". The phrase "technological arts" has been created and used by the courts to offer another view of the term "useful arts". See *In re Musgrave*, 167 USPQ (BNA) 280 (CCPA 1970). Hence, the first test of whether an invention is eligible for a patent is to determine if the invention is within the "technological arts".

Further, despite the express language of §101, several judicially created exceptions have been established to exclude certain subject matter as being patentable subject matter covered by §101. These exceptions include "laws of nature", "natural phenomena", and "abstract ideas". See *Diamond v. Diehr*, 450 U.S. 175, 185, 209 USPQ (BNA) 1, 7 (1981). However, courts have found that even if an invention incorporates abstract ideas, such as mathematical algorithms, the invention may nevertheless be statutory subject matter if the invention as a whole produces a "useful, concrete and tangible result." See *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* 149 F.3d 1368, 1973, 47 USPQ2d (BNA) 1596 (Fed. Cir. 1998).

This "two prong" test was evident when the Court of Customs and Patent Appeals (CCPA) decided an appeal from the Board of Patent Appeals and Interferences (BPAI). See *In re Toma*, 197 USPQ (BNA) 852 (CCPA 1978). In *Toma*, the court held that the recited mathematical algorithm did not render the claim as a whole non-statutory using the Freeman-Walter-Abele test as applied to *Gottschalk v. Benson*, 409 U.S. 63, 175 USPQ (BNA) 673 (1972). Additionally, the court decided separately on the issue of the "technological arts". The court developed a "technological arts" analysis:

The "technological" or "useful" arts inquiry must focus on whether the claimed subject matter...is statutory, not on whether the product of the claimed subject matter...is statutory, not on whether the prior art which the claimed subject matter purports to replace...is statutory, and not on

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whether the claimed subject matter is presently perceived to be an improvement over the prior art, e.g., whether it "enhances" the operation of a machine. *In re Toma* at 857.

In *Toma*, the claimed invention was a computer program for translating a source human language (e.g., Russian) into a target human language (e.g., English). The court found that the claimed computer implemented process was within the "technological art" because the claimed invention was an operation being performed by a computer within a computer.

The decision in *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* never addressed this prong of the test. In *State Street Bank & Trust Co.*, the court found that the "mathematical exception" using the Freeman-Walter-Abele test has little, if any, application to determining the presence of statutory subject matter but rather, statutory subject matter should be based on whether the operation produces a "useful, concrete and tangible result". See *State Street Bank & Trust Co.* at 1374. Furthermore, the court found that there was no "business method exception" since the court decisions that purported to create such exceptions were based on novelty or lack of enablement issues and not on statutory grounds. Therefore, the court held that "[w]hether the patent's claims are too broad to be patentable is not to be judged under §101, but rather under §§102, 103 and 112." See *State Street Bank & Trust Co.* at 1377. Both of these analysis goes towards whether the claimed invention is non-statutory because of the presence of an abstract idea. Indeed, *State Street* abolished the Freeman-Walter-Abele test used in *Toma*. However, *State Street* never addressed the second part of the analysis, i.e., the "technological arts" test established in *Toma* because the invention in *State Street* (i.e., a computerized system for determining the year-end income, expense, and capital gain or loss for the portfolio) was already determined to be within the technological arts under the *Toma* test. This dichotomy has been recently acknowledged by the Board of Patent Appeals and Interferences (BPAI) in affirming a

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§101 rejection finding the claimed invention to be non-statutory. See *Ex parte Bowman*, 61 USPQ2d (BNA) 1669 (BdPatApp&Int 2001).

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alain L. Bashore whose telephone number is 571-272-6739. The examiner can normally be reached on about 7:30 am to 5:00 pm (Mon. thru Thurs.).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on 571-272-1423. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Regarding all Class 705 applications, the management contact regarding examination is: Vincent Millin (SPE, art unit 3624) at 571-272-6747.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Alain L. Bashore
Primary Examiner
Art Unit 1762